

Appl. No. 10/706,392
Amdt. dated July 19, 2006
Reply to Office action of March 24, 2006

REMARKS/ARGUMENTS

Claims 1-12 are presently pending in the application as set forth in the Supplemental Amendment B filed January 4, 2006.

In this amendment, Claims 1, 7, 8 and 10 have been amended.

Claims 4 and 5 (which were withdrawn) have been canceled without prejudice to the filing of a continuation with respect thereto.

Claims 13-15 have been added.

Claims 2, 3, 6, 9, 11 and 12 remain unchanged.

As set forth below, the amendments to the Claims are believed to place the Claims in condition for allowance. In view of the amendments, as discussed below, reconsideration of the Application and issuance of a Notice of Allowability are respectfully requested.

Drawings

Per the Examiner's request, FIG. 3 has been amended to provide it with the legend "Prior Art". The drawing of FIG. 3 was not changed.

Amendment To Title

Per the Examiner's request, Applicant has changed the title of the application to "Copper/Gold Alloy Jewelry".

Amendments To The Specification:

The paragraph spanning pages 3-4 of the clean copy of the substitute specification was amended to remove the struck out text. The inclusion of this text in the clean copy was inadvertent. The specification has also been amended to provide positive verbal support for Claims 9-12. Because the added description merely describes what is shown in FIG. 2(a) of the application, the added description does not add new matter to the application.

Claim Objections

The Examiner objected to Claim 1, asserting that the claim did not have antecedent basis for "the improvement". Claim 1 has been amended to state "wherein the improvement comprises" which conforms to classic Jepson claim format. Withdrawal of the objection to Claim 1 is requested.

Claim 7 has been amended, and as amended, is believed to be clear. Withdrawal of this objection is requested.

In Claim 8, the Examiner asserted that there is no antecedent basis for "the application" in the last phrase of the claim. This last phrase states as follows: "said decorating part being deformable to fill said at least one groove upon the application of pressure to said decorating part." Hence, this phrase states that, the decorating part is deformed to fill the groove when pressure is applied to the decorating part. As such, "application" is not an element of the claim, and Claim 8 is believed to be in proper form as written. Applicant respectfully asserts that in Claim 8, the use of "the application" in claim

8 is analogous to the use of inherent components which do not require an antecedent recitation in the claim. See MPEP §2173.05(e). Withdrawal of this objection is requested.

Rejections Under §112

The Examiner rejected Claims 9-12 under 35 U.S.C. §112, first paragraph. Specifically, the Examiner has asserted that the claims contain subject matter "which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 9 depends from Claim 8 and provides that the "at least one groove" comprises "at least a pair of oppositely positioned grooves" positioned on opposite sides of the channel. This is clearly seen in FIG. 2(a) as shown below.

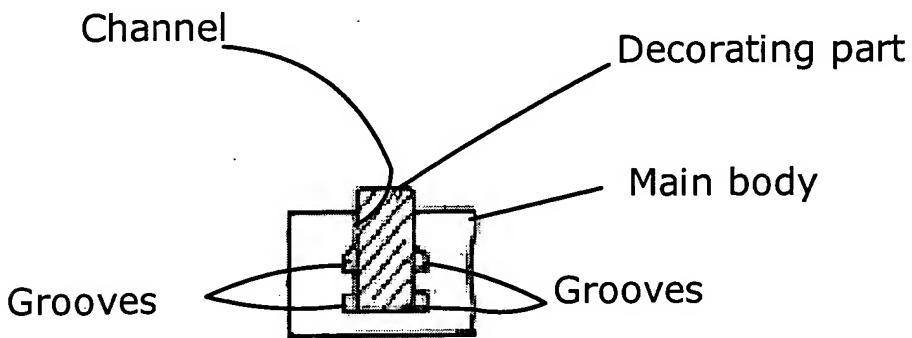


Fig. 2(a) shows all the elements of Claim 9. Claim 10 depends from Claim 9 and provides that the main channel comprises two pairs of grooves, with a first pair being proximate a bottom of the channel and a second pair being positioned about midway up the groove. This also is seen in FIG. 2(a). Claim 11 depends from Claim 10 and provides

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that the upper pair of grooves is shaped differently from the lower pair of grooves; and Claim 12 provides that the upper pair of grooves are generally trapezoidal in shape, while the lower pair of grooves are generally rectangular in shape. The elements of Claims 11 and 12 are also clearly seen in FIG. 2(a). In view of the fact that FIG. 2(a) shows all the elements of Claims 9-12, Applicant respectfully submits that he was in possession of the invention of Claims 9-12 at the time the application was filed. Withdrawal of this rejection is respectfully requested. Applicant notes that the specification has been amended to provide positive support for Claims 9-12 in the description of the invention. Because the amendment to the specification describes what is seen in FIG. 2(a), the amendment to the specification does not add new matter to the application. Withdrawal of this rejection to Claims 9-12 is requested.

Rejection Under §103

The Examiner has rejected Claims 1-3 and 6-8 under 35 U.S.C. §103(a) as "clearly anticipated by West, US- 6,062,045, in view of case law." It would appear that the Examiner is essentially continuing his rejection of the claims over West from the prior amendment. However, in this office action, the Examiner is rejecting the claims under §103, rather than under §102.

Initially, and as discussed in the prior amendment, West was solving a substantially different problem than Applicant is solving in his present invention. As set forth at Col. 8,

lines 17-24, West was solving the problem of providing highly wear resistant jewelry. West states:

"The principal concept of this invention is the provision of an ultra durable hard metal or high tech ceramic type of jewelry that may or may not incorporate precious metals and/or precious gem stones. The invention also provides a unique jewelry manufacturing process that combines hard metals with precious metals in a manner such that the precious metals are flush or recessed slightly below the outer most surfaces of the hard metals over the outer wear surfaces to achieve maximum abrasion and corrosion resistance."

To this end, West, in FIG. 5 shows a band of precious metal being received in a groove in a ring. Applicant, on the other hand and as noted in the prior amendment (the discussion from which is incorporated herein by reference), solves a substantially different problem – namely, providing a copper/gold alloy that "that naturally and uniformly changes color from a copper color to chocolate brown through oxidation", and, once tarnished from oxidation, can be polished to recover the original color of the decoration. Applicant notes that Claim 1 is in Jepson format to make clear that the decorating part being made of the alloy set forth in the claim is part of the inventive aspect of the invention.

"To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the

claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure." MPEP § 2143 (emphasis added) "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination" or modification. Further, "a statement that modifications of the prior art to meet the claimed invention would have been 'well within the ordinary skill of the art at the time the claimed invention was made' because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references." MPEP §2143.01 (emphasis in original).

As indicated by the excerpts from the MPEP cited above, establishing a *prima facie* case of obviousness requires that "the prior art references when combined must teach or suggest all of the claim limitations" and that there be a suggestion to modify the references as suggested by the Examiner (Emphasis added.) In the instant rejection, the Examiner has relied on only the West patent in asserting that the claimed invention is obvious. In the paragraph spanning pages 4-5 of the office action, the Examiner concedes that West does not show each and every element of Claim 1 or Claim 8. In particular, the Examiner has conceded that West does not teach or suggest the copper/gold alloy set forth in independent Claim 1 and 8. Further, West does not teach or suggest a copper/gold alloy which "naturally and uniformly changes color from a

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copper color to chocolate brown through oxidation and which can be polished back to recover the original color of the alloy" as is set forth in both independent Claims 1 and 8.

In support of his assertion that it would be obvious to use the claimed alloy, the Examiner disregards the claimed composition of the Applicant's alloy and states that West's disclosure that precious metals or other materials or other preformed metals can be used. Continuing, the Examiner states that:

"And though West does not give explicit percentages of materials, the examiner would like to point out that it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious engineering design choice. *In re Leshin*, 125 USPQ 416. It is also common knowledge to choose a material that has sufficient strength, durability, flexibility, hardness, and potential aesthetics (from applicant's disclosure on page 3, "...provides enjoyment"), etc, for the application, intended use, and design considerations of that material. Further, in addition, the examiner would also like to point out that such percentages as disclosed by applicant in the instant invention are merely the reverse of those percentages known in the art to comprise Shakudo Jewelry. Thus, it would also be readily understood and appreciated by those of ordinary skill in the art, of the known aptitude to combine varying percentages of different metals for purposes of obtaining different color schemes, and utilizing the different physical properties of each metal individually as well as the result combined, such as corrosion and hardness characteristics of a jewelry item."

Hence, the Examiner has stated two things: (1) that the choice of percentages is an obvious engineering design choice, and (2) since Applicant's percentages are the opposite that of traditional Shakudo alloy, it would have been obvious to flip the percentages to come up with Applicant's claimed percentages. Nothing could be further from the truth. Applicant's alloy, as set forth in the application and as explained in the prior amendment

accomplishes something that was not possible from the prior copper/gold Shakudo alloy – namely, that the alloy “naturally and uniformly changes color from a copper color to chocolate brown through oxidation and which can be polished back to recover the original color of the alloy.” To determine the percentages of gold and copper in the alloy is not “a matter of obvious engineer design choice” as the Examiner asserts. There is a whole continuum of copper/gold ratios or percentages that can be selected from, and the determination of the gold/copper ratio that is set forth in the application would require undue experimentation by one of ordinary skill in the art. Further, the Examiner appears to try bolster his obviousness assertion in noting that the claimed percentages are the opposite of the percentages of traditional Shakudo alloy. The fact that the percentages are flipped from traditional Shakudo alloy, however, does not make the claimed alloy obvious. The alloy composition could have been some other ratio; it just happens that this is the percentage that worked for the desired purpose. Thus, to place weight on the fact that the gold/copper ratio in the claimed alloy is opposite that of the gold/copper ratio of traditional Shakudo alloy is misplaced.

“To support the conclusion that the claimed invention is directed to obvious subject matter ... the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.” MPEP 706.0(j), citing *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). See also MPEP § 2144.03.A (“Official notice unsupported by documentary

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evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known"). As noted above, and as set forth in the prior amendment, the Examiner has not provided any reference which *teaches or suggests* the alloy as claimed in Claims 1 and 8. Nor has the Examiner provided a "convincing line of reasoning" as to why the claimed invention is obvious in light of West. As noted above (and as conceded by the Examiner) West does not teach the claimed alloy. Further, none of the references of record are believed to teach or suggest an alloy which consists of gold and copper in any particular ratio, let alone the ratio or percentages set forth in Claims 1 and 8. Thus, the Examiner has effectively taken official notice that the subject matter of Claims 1 and 8 are obvious. Other than pointing to the fact that West discloses the use of various materials, the Examiner has not cited any documentary evidence or otherwise presented "a convincing line or reasoning as to why" the claimed alloy is obvious. In accordance with MPEP 2144.03.C, Applicant therefore requests that the Examiner provide some teaching or suggestion to support the Examiner's contention that the alloy set forth in Claims 1 and 8 is obvious or that the Examiner withdraw the rejections to Claims 1 and 8.

New Claims

New claims 13-15 have been added. Claim 15 directed to the alloy that is set forth in Claims 1 and 8. Claims 14 and 15 depend from Claim 13. In view of the fact that Claim

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13 claims the alloy set forth in Claims 1 and 8, new Claim 13 does not add new issues or new matter to the application. Further, because it claims the very alloy that is set forth in Claims 1 and 8, examination of Claim 13 will not require an additional search on the part of the examiner.

As discussed above, none of the references of record teach or suggest an alloy as set forth in Claim 13. Hence, Claim 13 is believed to be in condition for allowance. Claims 14-15 depend from Claim 13 and are thus also allowable.

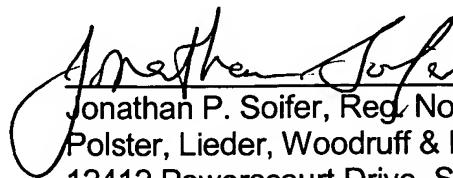
Summary

None of the references, whether considered individually or in combination teach or suggest the item of jewelry containing an alloy as set forth in Claims 1 or 8 or the alloy set forth in Claim 13.

In view of the foregoing, Claims 1-3 and 6-15 are believed to be in condition for allowance. A Notice of Allowability with respect to these claims is thus respectfully requested.

Respectfully Submitted,

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Amendments to the Drawings:

Filed herewith is a new drawing sheet containing FIG. 3. The drawing of FIG. 3 was not changed. However, FIG. 3 has been provided with the legend "PRIOR ART". Substitution of the originally filed sheet containing FIG. 3 with currently filed sheet is requested.

Enclosure: One (1) sheet of formal drawings.